

Docket No.: 99-113-US-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Anne E. Spinks
Serial No.: 10/623,278
Filed: July 18, 2003
Customer No.: 27091
Title: LOW MELT FLOW COMPOSITION

Art Unit: 1794
Examiner: Loney
Confirmation No.: 2410

MAIL STOP APPEAL BRIEF-PATENTS

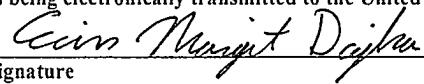
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Appellant submits the following Reply Brief in response to the Examiner's Answer dated March 21, 2008.

CERTIFICATE OF TRANSMISSION

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I. Status of Claims

Claims 1-20 are pending.

Claims 15 and 16 are allowed.

Claims 10, 11, and 17 are allowable if rewritten in independent form.

Claims 1-9, 12-14 and 18-20 stand rejected.

Claims 1-9, 12-14 and 18-20 are on appeal.

II. Grounds of Rejection to be Reviewed on Appeal

Whether claim 14 is patentable under 35 U.S.C. § 102(e) over U.S. 5,851,609 (Baratuci et al.)?

Whether claims 1, 2, 7, 12, 13 and 14 are patentable under 35 U.S.C. § 102(b) over U.S. 5,569,516 (Paeglis et al.)?

Whether claims 3-6, 8 and 9 are patentable under 35 U.S.C. § 103 over Paeglis et al.?

Whether claims 18-20 are patentable under 35 U.S.C. § 103 over Paeglis et al. in view of the Appellant's discussion of the prior art "ADPA" at page 5, lines 10-25 of Appellant's Specification?

III. Argument

A. 35 U.S.C. § 102(e)

1. Claim 14

To establish a *prima facie* case of anticipation of a claim, a single prior art reference must teach each and every element of the claimed composition. In addition, the composition must be shown in the reference “in as complete detail as contained in the claim.”” M.P.E.P. 2131 quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The Examiner treats claim 14 as a catalog of parts and identifies the location in Baratuci et al. that allegedly discloses each part. It is not appropriate to treat a claim as a catalog of parts and then to locate each part in a reference in an attempt to establish anticipation. Rather, for a reference to anticipate, each and every element of the claim must be arranged in the reference as it is arranged in the claim. *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984). Here, Baratuci et al. do not teach each and every element of the composition of claim 14, arranged as it is in claim 14. Baratuci et al. disclose that either the portion of their core that is not a preformed foam or all of their core can be an amorphous polymer. An amorphous polymer is a generic class of polymers as demonstrated by the fact that Baratuci et al. list more than thirteen classes and examples of amorphous polymers (see Baratuci et al., col. 5 line 54-col. 6, line 1). Amorphous polyalphaolefin, which is a polymer expressly recited in claim 14, is one example of a type of amorphous polymer. Baratuci et al. disclose that their amorphous polymer preferably is polyisobutylene or butyl rubber. Baratuci et al. further disclose that their composition can instead or in addition include amorphous polymers other than polyisobutylene and butyl rubber. However, at no point do Baratuci et al. specifically direct the skilled artisan to exclude polyisobutylene and butyl rubber when the composition also includes amorphous polyalphaolefin. Therefore, to arrive at such a composition, the skilled artisan would have to make a series of selections, i.e., select polyalphaolefin polymer from the generic class of amorphous polymers and then decide to exclude polyisobutylene and butyl rubber from the composition. Baratuci et al. do not direct the skilled artisan to make these particular selections. To the contrary, Baratuci et al. expressly disclose that their preferred composition includes amorphous polyalphaolefin polymer and isobutylene

polymers. Accordingly, the skilled artisan would not think to make the requisite selections. Baratuci et al. thus cannot be deemed to teach a composition that includes polyalphaolefin and is essentially free of polyisobutylene and butyl rubber. Accordingly, Baratuci et al. fail to anticipate the composition of claim 14. Appellant submits that the rejection of claim 14 under 35 U.S.C. § 102(e) over Baratuci et al. cannot stand and requests that it be withdrawn.

B. 35 U.S.C. § 102(b)

1. Claim 1

Nothing in the record establishes that the composition of Paeglis et al. adsorbs anything from an atmosphere to which it is exposed –let alone at least one of moisture and volatile organic species. The question is not whether one of Paeglis et al.’s fillers can adsorb moisture or a volatile organic species in the abstract. Rather, the question is whether the formulated composition of Paeglis et al. can adsorb at least one of moisture and volatile organic species from the atmosphere to which the composition is exposed. Paeglis et al. do not teach or suggest that it can, and nothing in the record establishes that it would inherently exhibit such a property. Thus, Paeglis et al. fail to teach each and every element of the composition of claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(b) over Paeglis et al. cannot stand, and Appellant respectfully requests that it be overruled.

2. Claim 13

It is undisputed that Paeglis et al. disclose that when an adsorbent is present in the roofing membrane composition, the composition also includes at least 60 parts by weight plasticizing oil per 100 parts elastomer. Appellant has discovered that an adsorbent composition that is essentially free of a film forming agent can exhibit useful properties including being pumpable and, when used as an adsorbent composition in a glass assembly, the assembly can be free from fogging over the useful life of the assembly (see, e.g., page 2, line 26 and page 2, line 31-page 3, line 2). Common sense informs the skilled artisan that if the adsorbent composition of claim 13 were to include 60 parts by weight plasticizing oil per 100 parts polyalphaolefin polymer, the composition would be

materially affected by the plasticizing oil. In particular, plasticizing oil, which necessarily decreases the viscosity of a composition, would affect the pumpability of the composition. In addition, the Examiner takes the position that plasticizing oil is a volatile organic compound. If we assume that the Examiner is correct, the volatile plasticizing oil would cause a glass assembly constructed therewith to fog. Accordingly, it cannot be disputed that the presence of a plasticizer oil in the amount required by Paeglis et al. would have a material effect on the composition of claim 13. For at least this additional reason, claim 13 is distinguishable under 35 U.S.C. § 102(b) over Paeglis et al.

C. 35 U.S.C. § 103

1. Claim 3

It is important to not be led astray as to what is taught by Paeglis et al. Paeglis et al. disclose what are asserted to be new copolymers. Paeglis et al. disclose properties of and uses for their new copolymers. Only one of the uses—roofing membranes—is described by Paeglis et al. as including an oil adsorbing mineral filler. The Examiner takes the position that the oil adsorbing mineral filler meets the criteria of the adsorbent referred to in claim 1. Therefore, the properties that Paeglis et al. ascribe to this use, i.e., roofing membranes, are the only properties that are relevant to the present inquiry, i.e., whether the disclosure of Paeglis et al. renders obvious the composition of claim 3. At no point do Paeglis et al. teach or suggest using their roofing membrane in a glazing. Therefore, the skilled artisan would have no reason to seek to modify the roofing membrane composition of Paeglis et al. to achieve a melt flow index suitable for glazing.

Paeglis et al. do mention glazing. However, this reference to glazing is with respect to their copolymer. In particular, Paeglis et al. disclose that their copolymer can be used in glazing. The fact that Paeglis et al. disclose that their copolymer can be used in glazing is of no moment. Paeglis et al. do not teach using a composition that includes their copolymer and an adsorbent in glazing. Again, it is disingenuous and misleading for the Examiner to assert anything to the contrary. Because there is no such teaching in Paeglis et al., the motivation alleged in the Examiner's Answer as the basis for the skilled artisan to seek to achieve a particular melt flow index does not exist. The record thus

fails to establish a *prima facie* case of obviousness of claim 3 under 35 U.S.C. § 103 over Paeglis et al.

2. Claim 6

Nothing in Paeglis et al. teaches or suggests that there is a reason to increase the amount of oil adsorbent filler in their roofing membrane composition. The oil adsorbent in Paeglis et al. is adding to the roofing membrane composition to adsorb plasticizer oil so as to prevent the oil from bleeding out of the roofing membrane. Thus, the adsorbent of Paeglis et al. adsorbs oil from the roofing membrane composition of Paeglis et al. The Examiner's Answer fails to establish why a skilled artisan would want to include from 40 % by weight to 70 % by weight adsorbent, as required by claim 6, in an adsorbent composition capable of adsorbing moisture or a volatile organic species from an atmosphere to which the adsorbent composition is exposed. As such, a *prima facie* case of obviousness of claim 6 has not been established. Appellant submits, therefore, that the rejection of claim 6 under 35 U.S.C. § 103 over Paeglis et al. cannot stand, and respectfully requests that it be overruled.

3. Claim 8

Again, the Examiner asserts, "With respect to claims 8 and 9, one would be motivated to form the composition of the recited properties since Paeglis et al. discloses the composition being used in the same filed [sic] as the applicant (i.e., glazings as indicated above)." Examiner's Answer, page 6. Again, Paeglis et al. do not teach using their roofing membrane composition, which is the only composition that Paeglis et al. disclose that includes a copolymer and an oil adsorbing filler, in glazing. Rather, Paeglis et al. disclose using their copolymer in glazing.¹ For the Examiner to imply a teaching to the contrary is disingenuous and misleading. Moreover, the copolymer of Paeglis et al. does not include an adsorbent. The copolymer of Paeglis et al. also is not inherently capable of adsorbing moisture or a volatile organic species from an atmosphere to which it is exposed. Thus, Paeglis et al. provide the skilled artisan with no reason to modify the

¹ See, e.g., Paeglis et al., col. 8, lines 61-67 ("In addition to the roofing application mentioned above, the thermoplastic elastomer of the invention is advantageously used in waterproof and weatherproof sheeting or covering, hose, tubing seals, rub strips, roll covers, ...glazing"). (Emphasis added.)

roofing membrane composition disclosed therein to achieve the properties of claims 8 and 9. For at least these additional reasons, the rejection of claims 8 and 9 under 35 U.S.C. § 103 over Paeglis et al. cannot be sustained. Applicant respectfully requests that it be overruled.

4. Claims 18-20

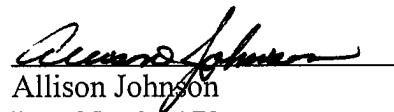
Neither the Examiner's Answer nor the record provides a reason the skilled artisan would select the particular adsorbents identified in claims 18-20 for use in the roofing membrane composition of Paeglis et al. The Examiner relies on the fact that these adsorbents existed in the prior art and are commercially available as the basis for his assertion that it would be obvious to include them in the roofing membrane of Paeglis et al. The Examiner has not carried his burden. There must be a reason the skilled artisan would select the particular adsorbents identified in claims 18-20. The fact that they were commercially available provides the skilled artisan no more reason to use them versus sugar. Paeglis et al. disclose that their mineral fillers must be oil adsorbing and must be able to reduce or eliminate bleed-out from a plasticizer oil. There is no evidence of record that the skilled artisan knew one way or another whether the adsorbents listed in claims 18-20 were oil adsorbing and able to reduce or eliminate bleed-out from a plasticizer oil when combined with the copolymer of Paeglis et al. Accordingly, the skilled artisan would have no reason to select the adsorbents of claim 18-20. The rejection of claims 18-20 under 35 U.S.C. § 103 over Paeglis et al. thus is not sound, and Appellant respectfully requests that the Board overrule the same.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. Appellant requests that the Board overrule the rejections of Record and direct the Examiner to pass the application to allowance.

Please charge any fees or credit any over payments to Deposit Account No. 06-2241.

Respectfully submitted,

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Allison Johnson
Reg. No. 36,173

Allison Johnson, P.A.
Lake Calhoun Executive Center
3033 Excelsior Blvd., Suite 467
Minneapolis, MN 55416
Telephone (612) 929-0700
Facsimile (612) 929-0706